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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,097	03/05/2001	Andrea Margaret Douglas	11375Z	6127
7590	03/21/2005			
Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530			EXAMINER DEBERRY, REGINA M	
			ART UNIT 1647	PAPER NUMBER
DATE MAILED: 03/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/819,097

Applicant(s)

DOUGLAS ET AL.

Examiner

Regina M. DeBerry

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 30-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03 January 2005 has been entered.

### ***Status of Application, Amendments and/or Claims***

The amendment filed 03 January 2005 has been entered in full. Claims 1-29 and 37-42 are cancelled. Claims 30-36 are under examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### **Claim Rejections - 35 USC § 112, First Paragraph, Enablement**

Claims 30-36 remain rejected under 35 U.S.C. 112, first paragraph, enablement. The basis for this rejection is set forth at pages 3-5 of the previous Office Action (02 December 2003).

Applicant submits that direction and guidance are provided throughout the specification for the instant invention. Applicant cites pages in the specification for support. Applicant states that the present application recognizes for the first time that cytokines, such as oncostatin M (OSM), interleukin-6 (IL-6), interleukin-11 (IL-11), leukemia inhibitory factor (LIF) and epidermal growth factor (EGF), have inhibitory effects on the proliferation of malignant breast cancer cells. Applicant states that the specification provides a thorough characterization of the inhibitory effects of OSM on the proliferation of malignant breast cancer cell *in vitro*, including inhibitory doses, and the effects on cell cycle, cell morphology and the expression of various cell surface receptors. Applicants maintain that those skilled in the art would consider that the *in vitro* characterizations provided in the specification are reasonably correlated to inhibitory effects of the selected cytokines on the proliferation of malignant breast cancer cells *in vivo*. Applicant maintains that they do not dispute that obstacles may exist, or that additional experimentation may be required to optimize the parameters for *in vivo* administration of a selected cytokine. Applicant contends that there is no evidence that the obstacles constitute undue experimentation and that some experimentation is permissible.

Applicant's arguments have been fully considered but not deemed persuasive. A considerable amount of time is permissible for the quantity of experimentation needed to make or use the invention based on the disclosure. However this depends on if the invention is routine or if the skilled artisan is given sufficient direction or guidance. In the instant case, the experimentation is not routine and Applicant has provided little

guidance. The pages cited by Applicant regarding amounts, administration, frequency, etc. are prophetic examples. The specification fails to teach the use of recognized animal models for cancer treatment. The specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. Lacking a working example however is a factor to be considered, especially in a case involving an unpredictable and/or undeveloped art. The Examiner cited various scientific references in the previous Office Action, to demonstrate the problems with correlating *in vitro* data with *in vivo* treatments and the unpredictability regarding anti-cancer drug discovery for cancer treatments. Based on the references provided by the Examiner, one skilled in the art would not consider the *in vitro* characterizations provided in the specification correlated to inhibiting the proliferation of malignant breast cancer cells in a mammal. Characteristics of cultured cell lines generally differ significantly from the characteristics of a primary tumor. Cells in culture exhibit characteristics different from those *in vivo* and cannot duplicate the complex conditions of the *in vivo* environment involved in host-tumor and cell-cell interactions.

The scientific reasoning and evidence as a whole indicates that the rejection should be maintained.

### **Conclusion**

No claims are allowed.


All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina M. DeBerry whose telephone number is (571) 272-0882. The examiner can normally be reached on 9:00 a.m.-6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda G. Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
RMD  
3/10/05

